REMARKS

CLAIM OBJECTIONS

The Office Action at page 2 objects to claims 9, 10, and 22 because of typographical errors regarding the dependency relationship of the claims. In response, Applicants have amended claims 9 and 10 to depend from claim 8. Applicants have amended claim 22 to depend from claim 21.

CLAIM REJECTIONS – 35 U.S.C. § 103 OVER HOSEA

Claims 1-3, 11-13, and 21-23 stand rejected under 35 U.S.C § 103(a) as unpatentable over Hosea (U.S. Pub No. 2002/0138331). To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). For the reasons discussed below, the Office Action does not establish a prima facie case of obviousness to reject Applicants' claims under 35 U.S.C § 103(a) as unpatentable over Hosea.

Hosea Does Not Teach Or Suggest
All Of Applicants' Claim Limitations

To establish a prima facie case of obviousness, Hosea must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583

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(CCPA 1974). Applicants' claims claim methods, systems, and computer program products for amending a session document during a presentation wherein the session document includes a session structured document. Hosea discloses methods and systems for web page personalization that having nothing to do with amending a session document during a presentation wherein the session document includes a session structured document as claimed in the present invention.

Turning to independent claim 1 of the present application, independent claim 1 claims:

1. A method for amending a session document during a presentation wherein the session document includes a session structured document, the method comprising:

   providing user profiles representing users capable of participating in presentations, each user profile including user classifications for a user;

   providing a presentation document including a structured document having structural elements classified with classification identifiers;

   identifying a user profile event for a user during the presentation; and

   adding to the session structured document at least one structural element from the presentation document, the added structural element having a classification identifier that corresponds to a user classification of the user.

Hosea Does Not Disclose Providing User Profiles Representing Users Capable Of Participating In Presentations, Each User Profile Including User Classifications For A User

The first element of claim 1 claims "providing user profiles representing users capable of participating in presentations, each user profile including user classifications for a user...." Regarding the first element of claim 1, the Office Action states on page 3:

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> providing user profiles representing users capable of participating in
> presentations, each user profile including user classifications for a user
> (e.g. Paragraph 0041, lines 5-14; Paragraph 0048: Discloses the use of a
> user profile that contains user preferences that include demographic and
> psychographic data. Paragraph 0042 describes how user preferences are
> generated. Hosea et al's invention of personalization of a web page is
> available to all requesting users. (Paragraph 0034, lines 1-8)...

That is, the Office Action takes the position that Hosea at paragraph 0041, lines 5-14, paragraph 0048, paragraph 0042, and paragraph 0034, lines 1-8, discloses the first element of claim 1. Applicants respectfully note in response, however, that what Hosea at paragraph 0041, lines 5-14, in fact discloses is:

> the Web page personalization component 124 accesses the user
> profile and a profile of the HTML file for the requested Web page,
> analyzes the data to match the Web page content to user
> preferences, and produces a modified version of the HTML file for
> the Web page, personalized in accordance with the user profile.
> The proxy server 114 preferably obtains the profile from a local
> user profile database 128. Each user profile may contain, for
> example, demographic and psychographic data.

That is, Hosea at paragraph 0041, lines 5-14, discloses personalizing a web page in accordance with a user profile. Hosea's personalizing a web page in accordance with a user profile is not providing user profiles representing users capable of participating in presentations, each user profile including user classifications for a user as claimed in the present application. In fact, Hosea at paragraph 0041, lines 5-14, does not even mention 'presentations,' 'participating in presentations,' 'users capable of participating in presentations,' or 'providing user profiles representing users capable of participating in presentations, each user profile including user classifications for a user.' Hosea discloses

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user's viewing customized web pages, but Hosea has nothing whatsoever to do with users capable of participating in presentations as claimed in the present invention. The specification at page 2, lines 4-6, describes presentations implemented according to presentation documents. The original specification at page 8, lines 18-19, further describes presentations documents as "composed of a presentation grammar (120) and a structured document (122)." Clearly the web pages of Hosea do not include a presentation grammar and a structured document. Because Hosea does not disclose each and every element and limitation of Applicants' claims, Hosea does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to paragraph 0048 of Hosea, Applicants respectfully note in response that what Hosea at paragraph 0048 in fact discloses is:

> Although a user profile database derived from clickstream data is preferably the main source for profile information, other sources of profile information may also be employed. For example, geographic information may readily be inferred from a user's IP address, which is transmitted with every URL request. An ISP may also supply user ZIP codes, which provide an alternative means to geographically profile a user. Geographic data could also be included in a stored user profile as described above. Geographic data may be used to deliver personalized content particular to a geographic area, such as local news and weather.

That is, Hosea at paragraph 0048 discloses deriving user profile data from a variety of sources. Hosea's deriving user profile data from a variety of sources is not providing user profiles representing users capable of participating in presentations, each user profile including user classifications for a user as claimed in the present application. In fact, Hosea at paragraph 0048 does not even mention 'presentations,' 'participating in presentations,' 'users capable of participating in presentations,' 'user classification,' or 'providing user profiles representing users capable of participating in presentations, each user profile including user classifications for a user.' Hosea discloses user's viewing

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customized web pages, but Hosea has nothing whatsoever to do with users capable of participating in presentations as claimed in the present invention. Because Hosea does not disclose each and every element and limitation of Applicants' claims, Hosea does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to paragraph 0042 of Hosea, Applicants respectfully note in response that what Hosea at paragraph 0042 in fact discloses is:

> User ID Sports Finance Movies Music TV ... Health Gardening 1
> 10.0 21.1 0.0 9.4 0.0 ... 50.0 85.0 (.82) (.75) (.62) (1.00) (.84)
> (1.00) (.77)

> In the illustrated example, each psychographic category in the profile includes an affinity rating, on a scale of 0.0 to 100.0, followed by a confidence measure for that affinity rating. Each user profile is preferably generated by tracking the user's actual Web surfing activity and analyzing the user's click-stream data, as described in the '755 application.

That is, Hosea at paragraph 0042 discloses a user profile that includes user affinity ratings for various categories and confidence measures for each rating. Hosea's user profile that includes user affinity ratings for various categories and confidence measures for each rating is not providing user profiles representing users capable of participating in presentations, each user profile including user classifications for a user as claimed in the present application. In fact, Hosea at paragraph 0042 does not even mention 'presentations,' 'participating in presentations,' 'users capable of participating in presentations,' 'user classification,' or 'providing user profiles representing users capable of participating in presentations, each user profile including user classifications for a user.' Hosea discloses user's viewing customized web pages, but Hosea has nothing whatsoever to do with users capable of participating in presentations as claimed in the present invention. Because Hosea does not disclose each and every element and

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limitation of Applicants' claims, Hosea does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to paragraph 0034, lines 1-8, of Hosea, Applicants respectfully note in response that what Hosea at paragraph 0034, lines 1-8, in fact discloses is:

> As discussed above, the inventive system is a method and system for dynamically personalizing published Web pages available on Web servers on the Internet for delivery to requesting users of the Web. The inventive system tailors the content of published Web pages in accordance with a profile of the requesting user at the time the request is made and delivers a personalized HTML file to the user.

That is, Hosea at paragraph 0034, lines 1-8, discloses is dynamically personalizing web pages available on the Internet. Hosea's dynamically personalizing web pages available on the Internet is not providing user profiles representing users capable of participating in presentations, each user profile including user classifications for a user as claimed in the present application. In fact, Hosea at paragraph 0034, lines 1-8, does not even mention 'presentations,' 'participating in presentations,' 'users capable of participating in presentations,' 'user classification,' 'each user profile including user classifications,' or 'providing user profiles representing users capable of participating in presentations, each user profile including user classifications for a user.' Hosea discloses user's viewing customized web pages, but Hosea has nothing whatsoever to do with users capable of participating in presentations as claimed in the present invention. Because Hosea does not disclose each and every element and limitation of Applicants' claims, Hosea does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

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<u>Hosea Does Not Disclose Providing A Presentation</u>
<u>Document Including A Structured Document Having</u>
<u>Structural Elements Classified With Classification Identifiers</u>

The second element of claim 1 claims "providing a presentation document including a structured document having structural elements classified with classification identifiers...." Regarding the second element of claim 1, the Office Action states on pages 3 and 4:

> providing a presentation document including a structured document having structural elements classified with classification identifiers; (An HTML file of the requested Web page is considered a presentation document, which is formed of constituent components that include content component and formatting components. (Paragraph 0043; lines 5-9) In addition, Hosea et al discloses of a HTML profile that includes classifications for the content components of the HTML file. (Paragraph 0043, lines 1-5; 11-14) Paragraph 0045, lines 14-16, discloses that the ability of the HTML file is combined with the HTML profile of being merged as one file, as in one document)...

That is, the Office Action takes the position that Hosea at paragraph 0043 and paragraph 0045, lines 14-16, discloses the second element of claim 1. Applicants respectfully note in response, however, that what Hosea at paragraph 0043 in fact discloses is:

> A profile includes classifications for the content components of the HTML file for the requested Web page. The profile of the HTML file for the requested Web page is based on the same or a similar content classification scheme to the user profiles. An HTML file is formed of constituent components that include content components and formatting components, i.e., the HTML "mark-up." The content components include but are not limited to text, images, advertisements and links to other Web

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pages. By way of example, a content component can comprise the hyperlinked subject heading "Arts & Humanities" 21. The profile of the HTML file for the requested Web page preferably includes a content classification or affinity rating for each content component on the Web page that is subject to personalization. An HTML file profiler parses each HTML file to extract the constituent components, and analyzes and assigns ratings to the content components.

That is, Hosea at paragraph 0043 discloses HTML document profiles that include classifications for the content components of the HTML document. Hosea's HTML document profiles that include classifications for the content components of the HTML document is not providing a presentation document including a structured document having structural elements classified with classification identifiers as claimed in the present application. In fact, Hosea at paragraph 0043 does not even mention 'presentation document,' 'presentation document including a structured document,' or 'providing a presentation document including a structured document having structural elements classified with classification identifiers.' The Office Action at the end of page 3 and the top of page 4 asserts that Hosea's web pages are presentation documents as claimed in the present invention. Applicants respectfully note, however, that web pages are not presentation documents. The original specification at page 8, lines 18-19, describes presentations documents as "composed of a presentation grammar (120) and a structured document (122)." Web pages are merely structured documents and do not include a presentation grammar and a structured document. The web pages of Hosea, therefore, are not presentation documents. Because Hosea does not disclose each and every element and limitation of Applicants' claims, Hosea does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to paragraph 0045, lines 14-16, of Hosea, Applicants respectfully note in response that what Hosea at paragraph 0045, lines 14-16, in fact discloses is:

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It is contemplated that an HTML file and its profile may be merged into one combined profiled version of the HTML file rather than maintained as two separate files.

That is, Hosea at paragraph 0045, lines 14-16, discloses merging an HTML file and its profile into one combined profiled version of the HTML file. Hosea's merging an HTML file and its profile into one combined profiled version of the HTML file is not providing a presentation document including a structured document having structural elements classified with classification identifiers as claimed in the present application. In fact, Hosea at paragraph 0045, lines 14-16, does not even mention 'presentation document,' 'presentation document including a structured document,' or 'providing a presentation document including a structured document having structural elements classified with classification identifiers.' As mentioned above, the Office Action at the end of page 3 and the top of page 4 asserts that Hosea's web pages are presentation documents as claimed in the present invention. Applicants respectfully note, however, that web pages are not presentation documents. The original specification at page 8, lines 18-19, describes presentations documents as "composed of a presentation grammar (120) and a structured document (122)." Web pages are merely structured documents and do not include a presentation grammar and a structured document. The web pages of Hosea, therefore, are not presentation documents. Because Hosea does not disclose each and every element and limitation of Applicants' claims, Hosea does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

<u>Hosea Does Not Disclose Identifying A User</u>
<u>Profile Event For A User During The Presentation</u>

The third element of claim 1 claims "identifying a user profile event for a user during the presentation...." Regarding the third element of claim 1, the Office Action at page 4 states:

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identifying a user profile event for a user during the presentation;
(Paragraph 0039; 0041 discloses the method of identifying a user ID in the
event of accessing a URL. Once ID is determined, the user profile
corresponding to the user ID is obtained and used to filter out content to
produce a modified Web page. (Paragraph 13, lines 9-14)...

That is, the Office Action takes the position that Hosea at paragraph 0039, paragraph
0041, and paragraph 0013, lines 9-14, discloses the third element of claim 1. Applicants
respectfully note in response, however, that what Hosea at paragraph 0039 in fact
discloses is:

The sniffer of the request generation component also extracts information
that may be used to correlate the URL request with a particular user
profile. User profiles may typically be stored by reference to anonymous
user IDs. So, for example, the sniffer may extract the client's IP address
and cross-reference an anonymous user ID table provided by the POP
server 112 to obtain the appropriate anonymous user ID for an HTTP
request. If multiple users share a single client 110, then each user may be
requested to register and to log in at the initiation of a Web session. That
log in information may be associated with a user's HTTP request to be
further associated with the anonymous user ID that is used to reference the
user's profile. Under some circumstances, for example, if the request
generation component 122 determines that requesting user does not have
an anonymous user ID and/or user profile, the associated HTTP request
may pass through the proxy server 114. The user ID information may be
stored locally in user profile database 128 or remotely, e.g., at the master
server 116 or at the POP server 112. User profile information may be
synchronized by the master server 116 periodically, if stored locally.

That is, Hosea at paragraph 0039 discloses a sniffer that extracts information that may be
used to correlate the URL request with a particular user profile. Hosea's sniffer is not

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identifying a user profile event for a user during the presentation as claimed in the present application. In fact, Hosea at paragraph 0039 does not even mention a 'user profile event,' 'presentation,' or 'identifying a user profile event for a user during the presentation.' Furthermore, Applicants note that a user profile event is described at page 35, line 14, of the original specification as "an event that results in adding a user classification to the set of user classifications for a presentation." Because Hosea at paragraph 0039, does not mention one word about a 'user classification,' 'set of user classifications for a presentation,' or 'an event that results in adding a user classification to the set of user classifications for a presentation,' Hosea at paragraph 0039 cannot possibly disclose a user profile event as claimed in the present application. Because Hosea does not disclose each and every element and limitation of Applicants' claims, Hosea does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to paragraph 0041 of Hosea, Applicants respectfully note in response that what Hosea at paragraph 0041 in fact discloses is:

> The personalization component 124 uses the user profile and a profile of the HTML file to edit the HTML file for the Web page. When the request generation component 122 generates an HTTP request that is eligible for personalization and associated with a user ID, the Web page personalization component 124 accesses the user profile and a profile of the HTML file for the requested Web page, analyzes the data to match the Web page content to user preferences, and produces a modified version of the HTML file for the Web page, personalized in accordance with the user profile. The proxy server 114 preferably obtains the profile from a local user profile database 128. Each user profile may contain, for example, demographic and psychographic data. For example, a user profile may take the following form:

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1 User ID Sports Finance Movies Music TV . . . Health Gardening 1 10.0
21.1 0.0 9.4 0.0 . . . 50.0 85.0 (.82) (.75) (.62) (1.00) (.84) (1.00) (.77)

That is, Hosea at paragraph 0041 discloses personalizing a web page in accordance with a user profile. Hosea's personalizing a web page in accordance with a user profile is not identifying a user profile event for a user during the presentation as claimed in the present application. In fact, Hosea at paragraph 0041 does not even mention a 'user profile event,' 'presentation,' or 'identifying a user profile event for a user during the presentation.' Applicants further note that a user profile event is described at page 35, line 14, of the original specification as "an event that results in adding a user classification to the set of user classifications for a presentation." Because Hosea at paragraph 0041, does not mention one word about a 'user classification,' 'set of user classifications for a presentation,' or 'an event that results in adding a user classification to the set of user classifications for a presentation,' Hosea at paragraph 0041 cannot possibly disclose a user profile event as claimed in the present application. Because Hosea does not disclose each and every element and limitation of Applicants' claims, Hosea does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to paragraph 0013, lines 9-14, of Hosea, Applicants respectfully note in response that what Hosea at paragraph 0013, lines 9-14, in fact discloses is:

> The user profiles may then be used to filter the content of the profiled Web pages for delivery to requesting users. A proxy server monitors user requests made through their Web clients, and filters the content of the requested page based on the user profile and the Web page profile, before delivering the page to the user.

That is, Hosea at paragraph 0013, lines 9-14, discloses filtering the content of profiled Web pages according to user profiles. Hosea's filtering the content of profiled Web pages according to user profiles is not identifying a user profile event for a user during

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the presentation as claimed in the present application. In fact, Hosea at paragraph 0013, lines 9-14, does not even mention a 'user profile event,' 'presentation,' or 'identifying a user profile event for a user during the presentation.' Applicants further note that a user profile event is described at page 35, line 14, of the original specification as "an event that results in adding a user classification to the set of user classifications for a presentation." Because Hosea at paragraph 0013, lines 9-14, does not mention one word about a 'user classification,' 'set of user classifications for a presentation,' or 'an event that results in adding a user classification to the set of user classifications for a presentation,' Hosea at paragraph 0013, lines 9-14, cannot possibly disclose a user profile event as claimed in the present application. Because Hosea does not disclose each and every element and limitation of Applicants' claims, Hosea does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

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<u>Hosea Does Not Disclose Adding To The Session Structured Document
At Least One Structural Element From The Presentation Document,
The Added Structural Element Having A Classification Identifier
That Corresponds To A User Classification Of The User</u>

The fourth element of claim 1 claims "adding to the session structured document at least one structural element from the presentation document, the added structural element having a classification identifier that corresponds to a user classification of the user." Regarding the fourth element of claim 1, the Office Action at page 4 states:

> Hosea et al fails to specifically disclose that adding to the session structured document at least one structural element from the presentation document, the added structural element having a classification identifier that corresponds to a user classification of the user. However, Hosea et al discloses in Paragraph 0047, lines 1-3, using the classification of each content component from the HTML profile/file to analyze its relevance to the requesting user wherein Paragraph 0046 discloses the process of comparing the components to the interests of the user and is either eliminated, rearranged, or new content may be added. Thus, a new modified Web page is created with the included components by the user preferences. (Paragraph 0047) It was well known to one of ordinary skill in the art at the time of the invention that each content component contained structural elements disclosing the location of the content component within the structure a HTML file. Hosea et al discloses these structural elements as formatting components within a HTML file in Paragraph 0043. Thus, when a content component is added or reorganized within Hosea et al's personalization web page method, structural elements would have been added or edited to disclose the new location of the content component within the modified version of the requesting user web page.

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That is, the Office Action admits that Hosea does not disclose the fourth element of claim 1. Instead, the Office Action implies that Hosea at paragraph 0047, paragraph 0046, and paragraph 0043 suggests the fourth element of claim 1. Applicants respectfully note in response, however, that what Hosea at paragraph 0047 in fact discloses is:

> The Web page personalization component 124 uses the classification of
> each content component from the profile to analyze its relevance to the
> requesting user. Content components may be matched to user profiles in
> any number of ways, for example, by using a certain threshold for the
> content affinity rating for a user to trigger content components
> corresponding to that content category. The proxy server 114 provides a
> modified Web page for display by creating a modified HTML file, with
> the included content components marked up with HTML code to specify
> the desired Web page display format.

That is, Hosea at paragraph 0047 discloses using the classification of each content component from the profile to analyze its relevance to the requesting user. Hosea's using the classification of each content component from the profile to analyze its relevance to the requesting user does not suggest adding to the session structured document at least one structural element from the presentation document, the added structural element having a classification identifier that corresponds to a user classification of the user as claimed in the present application. In fact, Hosea at paragraph 0047 does not even mention 'presentation document,' 'session structured document,' or 'adding to the session structured document at least one structural element from the presentation document.' Because Hosea at paragraph 0047 does not even mention many of the limitations in the fourth element of claim 1, paragraph 0047 cannot possibly suggest the fourth element of claim 1. Because Hosea does not disclose each and every element and limitation of Applicants' claims, Hosea does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

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Turning now to paragraph 0046 of Hosea, Applicants respectfully note in response that what Hosea at paragraph 0046 in fact discloses is:

> To personalize a requested Web page, the Web page personalization
> component 124 analyzes the respective user profile and HTML file profile
> to determine the most effective organization for the content of the
> requested Web page for display to that particular user. The proxy server
> 114 preferably accesses the profiled version of the HTML file from the
> HTML file profile database 127. In accordance with the inventive system,
> the content of the Web page may be reorganized in several ways to
> produce a modified, personalized Web page. Certain content components,
> if deemed to be of low interest to the user, may be eliminated from the
> Web page display altogether. Generally, it is preferred to preserve access
> to all of the content of the original Web page. A link to "Other" content or
> a link to the original Web page may be provided and a message that the
> Web page has been personalized may be included in the modified HTML
> file to ensure that the user is able to access all of the content, if desired.
> Other content components may be rearranged to position content for
> which the user has a higher affinity so that it is more easily viewed, for
> example, by moving it to the top of a list, moving it "above the fold," or
> setting it apart so that it has more white space around it. Additional
> content may also be inserted if desired. For example, certain
> advertisements or links to articles may be included or excluded. Other
> advertisements or links to articles may be moved to better target the user's
> preferences. Content may also be modified so that the font or color or
> other graphics properties are changed.

That is, Hosea at paragraph 0046 discloses analyzing the respective user profile and HTML file profile to determine the most effective organization for the content of the requested Web page for display to that particular user. Hosea's analyzing the respective user profile and HTML file profile does not suggest adding to the session structured

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document at least one structural element from the presentation document, the added structural element having a classification identifier that corresponds to a user classification of the user as claimed in the present application. In fact, Hosea at paragraph 0046 does not even mention 'presentation document,' 'session structured document,' or 'adding to the session structured document at least one structural element from the presentation document.' Because Hosea at paragraph 0046 does not even mention many of the limitations in the fourth element of claim 1, paragraph 0046 cannot possibly suggest the fourth element of claim 1. Because Hosea does not disclose each and every element and limitation of Applicants' claims, Hosea does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to paragraph 0043 of Hosea, Applicants respectfully note in response that what Hosea at paragraph 0043 in fact discloses is:

> A profile includes classifications for the content components of the HTML file for the requested Web page. The profile of the HTML file for the requested Web page is based on the same or a similar content classification scheme to the user profiles. An HTML file is formed of constituent components that include content components and formatting components, i.e., the HTML "mark-up." The content components include but are not limited to text, images, advertisements and links to other Web pages. By way of example, a content component can comprise the hyperlinked subject heading "Arts & Humanities" 21. The profile of the HTML file for the requested Web page preferably includes a content classification or affinity rating for each content component on the Web page that is subject to personalization. An HTML file profiler parses each HTML file to extract the constituent components, and analyzes and assigns ratings to the content components.

That is, Hosea at paragraph 0043 discloses HTML document profiles that include classifications for the content components of the HTML document. Hosea's HTML

document profiles that include classifications for the content components of the HTML document does not suggest adding to the session structured document at least one structural element from the presentation document, the added structural element having a classification identifier that corresponds to a user classification of the user as claimed in the present application. In fact, Hosea at paragraph 0043 does not even mention 'presentation document,' 'session structured document,' or 'adding to the session structured document at least one structural element from the presentation document.' Because Hosea at paragraph 0034 does not even mention many of the limitations in the fourth element of claim 1, paragraph 0034 cannot possibly suggest the fourth element of claim 1. Because Hosea does not disclose each and every element and limitation of Applicants' claims, Hosea does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

No Suggestion Or Motivation
To Modify Hosea

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Hosea. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The suggestion or motivation to modify Hosea must come from the teaching of Hosea itself, and the Examiner must explicitly point to the teaching within Hosea suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

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The Office Action makes no mention whatsoever of any place in Hosea that suggests or that provides any motivation for the proposed modification of Hosea. Instead, the Office Action at page 5 merely asserts that the modification of Hosea would be obvious to one of ordinary skill in the art. Such a bare assertion incorporates "hindsight" from the present application that is impermissible under *In re Surko*. Because the Office Action does not establish a prima facie case for obviousness, the rejections should be withdrawn, and the claims should be allowed.

In addition, Hosea in fact does not suggest or provide motivation for such a modification. Amending a session document during a presentation wherein the session document includes a session structured document as claimed in the present application includes, among other things, 'providing a presentation document including a structured document having structural elements classified with classification identifiers.' Hosea is directed toward a system for web page personalization having nothing whatsoever to do with a session document and a presentation document as claimed in the present application. Hosea, therefore, could not suggest or motivate the proposed modification. Because the Office Action does not establish a prima facie case for obviousness, the rejections should be withdrawn, and the claims should be allowed.

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Conclusion For Claim Rejections
Under 35 U.S.C. § 103 Over Hosea

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Claims 1-3, 11-13, and 21-23 stand rejected under 35 U.S.C § 103(a) as unpatentable over Hosea. For the reason discussed above, the proposed modification of Hosea does not establish a prima facie case of obviousness for independent claim 1 in the present application. Independent claim 1, therefore, is allowable. Independent claims 11 and 21 claim system and computer program product aspects, respectively, of the method claimed in independent claim 1. Independent claims 11 and 21 are allowable because independent claim 1 is allowable. The rejections of independent claims 1, 11, and 21, therefore, should be withdrawn, and claims 1, 11, and 21 should be allowed.

Claims 2-3, 12-13, and 22-23 depend from independent claims 1, 11, and 21, respectively. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the modification of Hosea does not disclose or suggest each and every element of the independent claims, so also the modification of Hosea cannot possibly disclose or suggest each and every element of any dependent claim. The rejections of claims 2-3, 12-13, and 22-23, therefore, should be withdrawn, and these claims also should be allowed.

In addition to the elements and limitations of the independent claims, the dependent claims 2-3, 12-13, and 22-23, also include such elements and limitations as 'the user profile event comprises adding a user to the presentation, wherein the added user has a new user classification for the presentation' and 'wherein the user profile event comprises changing a user classification in a user profile of a user who is participating in the presentation, wherein the changed user classification includes a new user classification for the presentation.' The proposed modification of Hosea not only does not disclose the elements of the independent claims, but Hosea does not disclose these additional elements. The rejections of claims 2-3, 12-13, and 22-23, therefore, should be withdrawn, and these claims also should be allowed.

CLAIM REJECTIONS – 35 U.S.C. § 103
OVER HOSEA IN VIEW OF LADD

Claims 4-7, 14-17, and 24-27 stand rejected under 35 U.S.C § 103(a) as unpatentable over Hosea (U.S. Pub. No. 2002/0138331) in view of Ladd, *et al.* (U.S. Patent No. 6,269,336). To establish a prima facie case of obviousness, the proposed combination of Hosea and Ladd must teach or suggest all of the claim limitations of dependent claims 4-7, 14-17, and 24-27. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The Office Action does not teach or suggest all of the claim limitations of claims 4-7, 14-17, and 24-27 because the rejection of claims 4-7, 14-17, and 24-27 relies on the previous 35 U.S.C. § 103 rejection. The previous 35 U.S.C. § 103 rejection argues that the proposed modification of Hosea discloses each and every element and limitation of

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independent claims 1, 11, and 21. As Applicants have demonstrated above, the proposed modification of Hosea does not disclose each and every element of independent claims 1, 11, and 21. Dependent claims 4-7, 14-17, and 24-27 depend from independent claims 1, 11, and 21 respectively and include all of the limitations of the claims from which they depend. Because the proposed combination of Hosea and Ladd relies on the argument that the modification of Hosea discloses each and every element claims 1, 11, and 21, and because the modification of Hosea discloses each and every element claims 1, 11, and 21, the proposed combination of Hosea and Ladd cannot teach or suggest all the claim limitations of claims 4-7, 14-17, and 24-27. The proposed combination of Hosea and Ladd, therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn.

In addition to the elements and limitations of the independent claims, the dependent claims 4-7, 14-17, and 24-27, also include such elements and limitations as 'adding a grammar element to the session grammar in dependence upon the added structural element,' 'comprising creating a session document from a presentation document, including: identifying a presentation document for a presentation, the presentation document including a presentation grammar and a structured document having structural elements classified with classification identifiers; identifying a user participant for the presentation, the user having a user profile comprising user classifications; and filtering the structured document in dependence upon the user classifications and the classification identifiers,' and 'filtering the structured document comprises: extracting, from the structured document, structural elements having classification identifiers corresponding to the user classifications; and writing the extracted structural elements into a session structured document in the session document,' and 'filtering the presentation grammar, in dependence upon the extracted structural elements, into a session grammar in the session document.' The proposed modification of Hosea not only does not disclose the elements of the independent claims, but Hosea does not disclose these additional elements. The rejections of claims 4-7, 14-17, and 24-27, therefore, should be withdrawn, and these claims also should be allowed.

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CLAIM REJECTIONS – 35 U.S.C. § 103 OVER HOSEA
IN VIEW OF LADD IN FURTHER VIEW OF HUANG

Claims 8-10, 18-20, and 28-30 stand rejected under 35 U.S.C § 103(a) as unpatentable
over Hosea (U.S. Pub. No. 2002/0138331) in view of Ladd, *et al.* (U.S. Patent No.
6,269,336) in further view of Huang (U.S. Pub. No. 2001/0032218). To establish a prima
facie case of obviousness, the proposed combination of Hosea, Ladd, and Huang must
teach or suggest all of the claim limitations of dependent claims 8-10, 18-20, and 28-30.
In re Royka, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The Office Action
does not teach or suggest all of the claim limitations of claims 8-10, 18-20, and 28-30
because the rejection of claims 8-10, 18-20, and 28-30 relies on the previous 35 U.S.C. §
103 rejection. The previous 35 U.S.C. § 103 rejection argues that the proposed
modification of Hosea discloses each and every element and limitation of independent
claims 1, 11, and 21. As Applicants have demonstrated above, the proposed modification
of Hosea does not disclose each and every element of independent claims 1, 11, and 21.
Dependent claims 8-10, 18-20, and 28-30 depend from independent claims 1, 11, and 21
respectively and include all of the limitations of the claims from which they depend.
Because the proposed combination of Hosea, Ladd, and Huang relies on the argument
that the modification of Hosea discloses each and every element claims 1, 11, and 21, and
because the modification of Hosea discloses each and every element claims 1, 11, and 21,
the proposed combination of Hosea, Ladd, and Huang cannot teach or suggest all the
claim limitations of claims 8-10, 18-20, and 28-30. The proposed combination of Hosea,
Ladd, and Huang, therefore, cannot establish a prima facie case of obviousness, and the
rejections should be withdrawn.

In addition to the elements and limitations of the independent claims, the dependent
claims 8-10, 18-20, and 28-30, also include such elements and limitations as creating a
presentation document, including: creating, in dependence upon an original document, a
structured document comprising one or more structural elements; classifying a structural
element of the structured document according to a presentation attribute; and creating a
presentation grammar for the structured document, wherein the presentation grammar for

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the structured document includes grammar elements each of which includes an identifier for at least one structural element of the structured document,' 'classifying a structural element comprises: identifying a presentation attribute for the structural element; identifying a classification identifier in dependence upon the presentation attribute; and inserting the classification identifier in association with the structural element in the structured document,' and 'creating a presentation grammar for the structured document comprises: identifying the content type of the original document; selecting, in dependence upon the content type, a full presentation grammar from among a multiplicity of full presentation grammars; and filtering the full presentation grammar into a presentation grammar for the structured document in dependence upon the structural elements of the structured document. The proposed modification of Hosea not only does not disclose the elements of the independent claims, but Hosea does not disclose these additional elements. The rejections of claims 8-10, 18-20, and 28-30, therefore, should be withdrawn, and these claims also should be allowed.

CONCLUSION

Claims 1-3, 11-13, and 21-23 stand rejected under 35 U.S.C § 103(a) as unpatentable over Hosea (U.S. Pub No. 2002/0138331). For the reasons discussed above, the proposed modification of Hosea does not establish a prima facie case for obviousness. Claims 1-3, 11-13, and 21-23, therefore, are patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-3, 11-13, and 21-23.

Claims 4-7, 14-17, and 24-27 stand rejected under 35 U.S.C § 103(a) as unpatentable over Hosea (U.S. Pub. No. 2002/0138331) in view of Ladd, *et al.* (U.S. Patent No. 6,269,336). For the reasons discussed above, the proposed combination of Hosea and Ladd does not establish a prima facie case for obviousness. Claims 4-7, 14-17, and 24-27, therefore, are patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 4-7, 14-17, and 24-27.

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Claims 8-10, 18-20, and 28-30 stand rejected under 35 U.S.C § 103(a) as unpatentable over Hosea (U.S. Pub. No. 2002/0138331) in view of Ladd, *et al.* (U.S. Patent No. 6,269,336) in further view of Huang (U.S. Pub. No. 2001/0032218). For the reasons discussed above, the proposed combination of Hosea, Ladd, and Huang does not establish a prima facie case for obviousness. Claims 8-10, 18-20, and 28-30 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 8-10, 18-20, and 28-30.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: <u>April 28, 2006</u>   By:

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